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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,512	12/08/2003	Wolfgang Witz	29617/37215B	2347

4743 7590 05/31/2005

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EXAMINER

LE, HUYEN D

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/730,512	Applicant(s) WITZ ET AL.	
	Examiner Huyen Le	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.  
 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 28-36 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☒ Claim(s) 29-36 is/are allowed.  
 6) ☒ Claim(s) 1-3, 7, 8 and 28 is/are rejected.  
 7) ☒ Claim(s) 4-6 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/17/05</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 1 recites "the portion of the tip disposed within the feed tube extends a portion of the length of the feed tube" which is not previously described in the specification.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 7, 8, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufmann (6,183,155).

The Kaufmann reference discloses a marking instrument comprising a housing 2 (Figures 4 and A-A'), a reservoir 7 for storing fluid ink 6 within the housing 2, a feed tube 18 including U-shaped portions to convey fluid ink, communicating with the reservoir 7, a porous tip 10 disposed within the feed tube 18 for conveying ink to a substrate at a marking end of the tip 10, a porous buffer 16 disposed within the housing 2 adjacent the feed tube 18 and configured for storing ink 6 during periods of a decreasing pressure differential between the reservoir and the atmosphere, a passage 24 formed between the outside surface of the tip 10 and the inside surface of the feed tube (Fig. A-A').

Although the Kaufmann does not specifically disclose the dimension of the passage 24 to be in the range between about 0.010 in to about 0.025 in, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a thickness for the passage within a certain range to best fit a particular feed tube and writing tip design and to optimize the performance. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

Regarding claim 3, a portion of the buffer 16 is disposed in capillary coupling contact with a portion of the tip (shown in Fig. A-A').

Regarding claim 7, the capillary of the tip is greater than the capillarity of the buffer and greater than the capillarity of the passage.

Regarding claim 8, the tip is secured against substantial movement in the axial direction.

Regarding claim 28, a portion of the length of the buffer 16 is disposed in capillary coupling contact to a portion of the length of the tip (Fig. A-A').

#### ***Allowable Subject Matter***

4. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claims 29-36 are allowed.

#### ***Response to Arguments***

6. Applicant's arguments filed 03/14/2005 have been fully considered but they are not persuasive.

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In regard to the applicant's argument that Kaufmann does not disclose a porous tip disposed within a feed tube, the examiner respectfully disagrees with the applicant. The feed tube of Kaufmann includes two U-shaped portions as shown in Fig. A-A' and the porous tip 10 is disposed within the two portions of the feed tube.

In regard to the applicant's argument that Kaufmann discloses the wick 10 extending the entire length of the feed tube instead of the portion of the tip disposed within the feed extending a portion of the length of the feed tube as claimed, the examiner respectfully disagrees with the applicant. The phrase "the portion of the tip disposed within the feed tube" does not limit the tip to a definite or finite length or location. The wick 10 of Kaufman can include portions that are disposed in the feed tube and one of the portions of the wick 10 extends a portion of the length of the feed tube.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen Le whose telephone number is 571-272-4890.

The examiner can normally be reached on Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HL  
May 26, 2005

  
**JUSTINE R. YU**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**

5/26/05